

Attorney Docket No.: 27611/38972A (UIC0002US)
Inventors: Wang, Zaijie
Serial No.: 10/769,536
Filing Date: January 30, 2004
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REMARKS

Claims 28-29 are pending in this application. Claim 29 has been withdrawn from consideration and canceled. No new matter has been added by this amendment. Applicant is respectfully requesting reconsideration of the restriction requirement in view of the following remarks.

I. Restriction Requirement Under 35 U.S.C. §121

The pending claims have been subjected to a Restriction Requirement under 35 U.S.C. §121. The Examiner suggests that restriction of the present invention into the following groups is required:

Group I, claim 28, drawn to a method preventing or reversing the chronic actions of an opium alkaloid comprising administering a calcium calmodulin dependent protein kinase (CaMKII), classified in various classes depending upon the inhibitor; and

Group II, claim 29, drawn to a composition comprising an inhibitor of the activity of CaMKII, an opium alkaloid and an excipient, classified in various classes depending upon the structure of the inhibitor.

The Examiner suggests that Inventions I and II are related as product and process of use; however, are distinct because the product as claimed can be used in a materially different process, e.g., to treat pain. It is further suggested that the method can be practiced with materially different products such as partial agonists of the NMDA receptor. It is suggested that a search of both Inventions I and II together would impose a serious burden on the Examiner because of the vast plethora of molecules that range from chemicals to peptides for CaMKII inhibitors and the

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plethora of opium alkaloids, as well as the different text searches for the various methods encompassed by preventing or reversing chronic actions of an opium alkaloid, e.g., tolerance, addiction, and withdraw.

Applicant's election with traverse of claim 28, i.e., now Group I, in the reply filed April 28, 2006 has been acknowledged by the Examiner. Claim 29 has been withdrawn from consideration as being drawn to a non-elected invention. Accordingly, Applicant has canceled claim 29 without prejudice, reserving the right to file continuing applications for the canceled subject matter.

II. Species Election

The Examiner suggests that the claims pending in this case contain the patentably distinct species of 1) inhibitors of calcium calmodulin dependent kinase II (claims 28 and 29) and 2) opiate alkaloids (claim 29). It is suggested that the species are independent or distinct because the specific CaMK inhibitors are not disclosed as capable of use together, are structurally different and can be used in different methods. It is further suggested that the opiate alkaloids can be used for more than just treating pain. The Examiner acknowledges Applicant's clarification of the CAMKII inhibitors in the amendment filed April 28, 2006; however, it is suggested that the different inhibitors have different classifications depending upon whether they are small peptides, proteins, or chemical compounds and would require a different field of search, i.e., structure or sequence searching. The Examiner suggests that the searches do not overlap just because they have the same title and the different inhibitors can have different modes of operation or

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effect. The Examiner requires Applicant to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim (i.e. claim 28) is finally held to be allowable. Applicant respectfully disagrees and traverses this species election.

At the outset, Applicant respectfully wishes to point out that the instant application only has a generic claim pending. Wherein Applicant only presents a generic claim, no restriction can be required. See MPEP 809.02(d).

Furthermore, MPEP 806.04(b) indicates that, while usually independent, species may be related under the particular disclosure. In this regard, Applicant has presented generic claim 28, which clearly sets forth the relationship amongst the claimed genus of inhibitors, i.e., inhibiting the activity of calcium calmodulin dependent protein kinase II. A search and examination of this genus of inhibitors is neither unduly or burdensome as the applicability of any particular small molecule, peptide or protein to the claimed method must be via the common effect of inhibiting CaMKII activity.

Moreover, the PTO guidelines are quite clear that the field of search must be pertinent to the type of subject matter covered by the claims. As applied to claim 28, a search of the prior art based upon the structure or sequence of a particular small molecule, peptide or protein would not be an informative search relevant to the instant claim as the result of such a search would merely provide the structure or sequence of similar molecules with possibly no associated activity toward CaMKII. The claims pending in this case are not drawn to a particular composition with a particular structure or sequence. Rather,

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Applicant is drawing claim to a particular activity which achieves the desired outcome of preventing or reversing the chronic actions of an opium alkaloid, namely inhibiting the activity of calcium calmodulin dependent protein kinase II. As such, Applicant is entitled to have the claim as presented searched and examined on the merits. In light of these remarks, reconsideration and withdrawal of the required species election is respectfully requested.

Respectfully submitted,



Jane Massey Licata
Registration No. 32,257

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Licata & Tyrrell P.C.
66 E. Main Street
Marlton, New Jersey 08053

(856) 810-1515